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PATENT
Customer No. 22,852
Attorney Docket No. 4121.0003-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
SORGE et al.) Group Art Unit: 1637
)
Application No.: 08/529,767) Examiner: J. Fredman
)
Filed: September 15, 1995)
)
For: NOVEL POLYMERASE)
)
COMPOSITIONS AND USES)
)
THEREOF)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Michael Woodward
Crystal Mall 1 - 7th Floor

Sir:

INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(c), Applicants bring to the attention of the Examiner the documents listed on the attached form and the following information. This Information Disclosure Statement is being filed after the events recited in Section 1.97(b). To the undersigned's knowledge, there is no current Final Office Action, Notice of Allowance, or action that otherwise closes prosecution.¹ Under the

¹ A Final Office Action was mailed February 24, 1997. The Supplemental Amendment that was filed December 10, 1997, confirms a telephone discussion in which Examiner Campbell stated that the finality of that Office Action was being withdrawn and that the application was in condition for allowance. Subsequent to December 10, 1997, no written communications in this case have been received from the United States Patent and Trademark Office ("USPTO"). The Third Supplemental Amendment that was filed January 28, 2003, reports a telephone call with Examiner Fredman, in which Examiner Fredman noted that claim 9 had depended from a canceled claim. In the Third Supplemental Amendment, claim 9 was canceled without prejudice or disclaimer.

provisions of 37 C.F.R. § 1.97(c), this Information Disclosure Statement is accompanied by a fee of \$180.00 as specified by Section 1.17(p).

Copies of the listed documents are attached. One of those documents is a copy of the Request for Reexamination for parent U.S. Patent No. 5,556,772 ("the '772 patent"). One of those documents is a copy of the Notice of Reexamination Request Filing Date, which was mailed from the USPTO. Several of those documents are copies of documents from the following three U.S. District Court litigations involving the '772 patent:

Stratagene v. Invitrogen Corporation ("Invitrogen"), United States District Court for the District of Maryland, Southern Division, Civil Action No. DKC 01-3566 ("Case 1");

Stratagene v. Takara Holdings, Inc. and Takara Bio, Inc. ("Takara"), United States District Court for the District of Maryland, Southern Division, Civil Action No. WMN 02 CV 3603 ("Case 2"); and

Takara Bio, Inc. v. Stratagene, United States District Court for the Southern District of California, Case No. 03 CV 0742B AJB ("Case 3").²

In Case 1, Stratagene asserted that Invitrogen infringed the '772 patent. In Case 1, Invitrogen has alleged that the '772 patent is unenforceable in view of alleged inequitable conduct and is invalid under 35 U.S.C. §§ 102 and 103. Information related to Invitrogen's allegations of inequitable conduct and invalidity are contained, e.g., in the enclosed copies of: (1) Invitrogen Corporation's Answer to Complaint For Patent Infringement And Counterclaim and (2) Expert Opinion of Thomas G. Wiseman, Esq.

² Applicants also enclose copies of docket sheets for each of those three cases, which provide a list of pleadings filed in those cases. If the USPTO requests copies of further documents, they will be provided to the extent permissible under the protective order.

("Wiseman Opinion"). Invitrogen also submitted an Expert Report of Thomas A. Kunkel, Ph.D. ("Kunkel Report"), which also discusses certain positions on certain issues such as invalidity, claim construction, and infringement. The undersigned was informed by Stratagene's litigation counsel Marc Labgold that the Kunkel Report cannot be submitted to the USPTO in view of the protective order in the litigation by which Invitrogen has designated certain information as confidential.

The assertions of invalidity by Invitrogen, including those in the Wiseman Opinion and the Kunkel Report, are summarized as follows. Invitrogen alleges that U.S. Patent 5,436,149 to Barnes anticipates claims 1 to 13 of the '772 patent. Invitrogen also alleges that claims 1 to 13 of the '772 patent are obvious to what they have defined as one of ordinary skill in the art over either Perrino and Loeb, *Proc. Natl. Acad. Sci., USA*, 86(9):3085-3085 (1989) or Perrino and Loeb, *Biochemistry*, 29(22):5226-5231 (1990) alone, or in combination with Tindall and Kunkel, *Biochemistry*, 29(16):6008-6013 (1988) ("Tindall and Kunkel") and Lundberg, *Gene*, 108:1-6 (1991) or with Tindall and Kunkel and the New England Biolab catalog on Deep Vent® DNA polymerase (1992).

Information related to Stratagene's positions on Invitrogen's allegations of inequitable conduct and invalidity are contained, e.g., in the enclosed copies of: (1) Stratagene's Answer to Invitrogen Corporation's Counter Claim and (2) Expert Witness Report of John F. Witherspoon.

Stratagene also submitted an Expert Statement of Joseph O. Falkinham, III and Rebuttal Report of Joseph O. Falkinham, III, Ph.D., which also discusses certain positions on certain issues such as invalidity, claim construction, and infringement. The undersigned was informed by Stratagene's litigation counsel Marc Labgold that copies

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of those two papers cannot be submitted to the USPTO in view of the protective order in the litigation by which Invitrogen has designated certain information as confidential.

In Case 2, Stratagene asserted that Takara infringed the '772 patent. Takara's "Motion to (1) Quash Service of Process, (2) Dismiss for Inadequate Service of Process, and (3) Dismiss for Lack of Personal Jurisdiction, or (4) -- If This Court Has Jurisdiction - Transfer" ("Takara Motion"), Takara alleges work of Wayne Barnes prior to the February 19, 1993, filing date of the application that issued into U.S. Patent No. 5,436,149 (Takara Motion at 2). The Takara Motion also discusses alleged activity of Barnes relative to Stratagene (*Id.* at 2 and 3). The Takara Motion also mentions an alleged dispute regarding issues relating to inventorship of the '772 patent (*Id.* at 3).

In Case 3, Takara Bio requests correction of inventorship of the '772 patent to include Wayne Barnes as an inventor. Takara Bio's Complaint Under the Patent Law ("Takara Bio Complaint") includes allegations related to Takara Bio's request to correct inventorship of the '772 patent.

Applicants respectfully request that the Examiner consider the listed documents and information discussed in this Information Disclosure Statement and evidence that consideration by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicants determine that the cited documents do not constitute "prior art" under United States law,

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Applicants reserve the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

Applicants further reserve the right to take appropriate action to establish the patentability of the claimed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 27, 2003

By: Charles E. Van Horn #40266
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